

SEP 03 2003

1636



TECHNICAL 150/2000 Patent

Attorney's Docket No. 012627-024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Colin L. MASTERS <i>et al.</i>)	Group Art Unit: 1636
)	
Application No.: 09/914,770)	Examiner: Daniel M. Sullivan
)	
Filed: January 2, 2002)	Confirmation No.: 4119
)	
For: COPPER AGONIST THAT BINDS ON)	
THE COPPER BINDING SITE OF APP)	
AND/OR EXERTS AND INHIBITING)	
EFFECT ON THE RELEASE OF)	
AMYLOID A β PEPTIDE)	

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

[] A Petition for Extension of Time is also enclosed.

[] A Terminal Disclaimer and the [] \$55.00 (2814) [] \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.

[X] Also enclosed is/are Copy of Postcard Receipt dated 9/4/2001; Copy of Preliminary Amendment Filed on 9/4/2001.

[X] Small entity status is hereby claimed.

[X] No additional claim fee is required.

[] An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADD'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Claim Amendment Fee					
If small entity status is claimed, subtract 50% of Total Claim Amendment Fee					
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					

☐ A total fee in the amount of \$ _____ is enclosed.

☐ Charge \$ _____ to Deposit Account No. 02-4800.

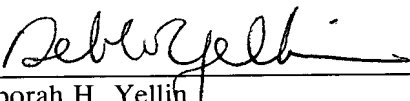
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: August 29, 2003

By:


Deborah H. Yellin
Registration No. 45,904

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620



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TECHNICAL Patent
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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APP AND/OR EXERTS AN)
INHIBITING EFFECT ON THE)
RELEASE OF AMYLOID A β)
PEPTIDE)
)

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is timely filed in complete response to the Office Action [Requirement for Restriction] mailed July 29, 2003.

Election

Applicants elect Group II (drawn to the use of a copper agonist for prevention or treatment of Alzheimer's disease), with traverse, to comply with the requirements of a complete response to the restriction.

Preliminary Amendment filed September 4, 2001

Applicants note that on September 4, 2001, a Preliminary Amendment was filed with the application as-filed pursuant to 35 U.S.C. § 371. Attached herewith is the post

card, stamped by the U.S. Patent and Trademark Office on September 4, 2001, acknowledging receipt of the Preliminary Amendment. Also attached is the Preliminary Amendment as filed on September 4, 2001. Applicants request entry and acknowledgement of same.

Applicants thank the Examiner for taking time to discuss this issue with Applicants' representative on August 29, 2003. As the Preliminary Amendment amended claims 1-3 to method claims for the treatment of Alzheimer's disease using the copper agonist, Applicants have elected (with traverse) for examination claims 1-4. Pursuant to the discussion with the Examiner, claims 1-3, as amended in the Preliminary Amendment, are rejoined with claim 4, as drawn to a method for the prevention or treatment of Alzheimer's Disease using a copper agonist. Group I (claims drawn to a copper agonist which binds to the copper binding site of the amyloid precursor protein and/or reduces or prevents release of A β peptide) no longer applies to the claims as amended in the Preliminary Amendment of September 4, 2001. Thus, Applicants discuss the outstanding restriction with regard to only Groups II and III.

Turning now to the Restriction Requirement, Applicants request rejoinder and examination of the claims of Groups II and III.

The instant application is a national phase application of an International PCT Application. Unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. 37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.*

The claims are directed to a method of making and a method of using a copper agonist characterized in that it reduces or prevents release of A β peptide. The inventions are related by the special technical feature of the copper agonist. The Restriction Requirement cites to Borchardt *et al.* (2000) *Cell. Mol. Biol.* 46:785-795, as purportedly meeting the subject matter of the copper agonist as claimed in the claims of Group I.

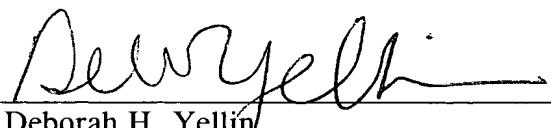
However, Applicants note that pursuant to the Preliminary Amendment of September 4, 2001, Applicants are no longer claiming a copper agonist which binds to the copper binding site of the amyloid precursor protein and/or reduces or prevents release of A β peptide. Rather, Applicants now claim methods for the prevention and treatment of Alzheimer's Disease using a copper agonist, and methods of identifying the copper agonist. Thus, Groups II and III share a technical features that defines a contribution over the art.

Further, under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent and distinct inventions. Again, Applicants note that a search of Groups II and III would not be burdensome, both groups relate to the use or identification of a copper agonist and a search would greatly overlap. The restriction should be withdrawn or, at the very least, reconsidered.

Should the Examiner have any questions or helpful suggestions concerning the subject application, she is respectfully requested to contact Applicants' undersigned representative at (703) 838-6563.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Deborah H. Yellin
Registration No. 45,904

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: August 29, 2003

Applicant/Inventor: Colin J. MASTERS

Appln. No. New Application

Docket No.: 012627-024

Work Atty: TSR

Date: 9-4-01

Title: COPPER AGONIST THAT BINDS ON THE COPPER BINDING SITE OF APP AND/OR EXERTS AN INHIBITING EFFECT ON THE RELEASE OF AMYLOID A β PEPTIDE

The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- ☐ Transmittal Letter to the U.S. Receiving Office/Response to Invitation (PTO-1382)
- ☒ Transmittal Letter to U.S. Designated/Elected Office (DO/EQ/US) Concerning Filing Under 35 USC 371 (PTO-1390)
- ☐ PCT Request (PCT/RO/101) () pgs. Including
 - ☒ specification (pages 1 - 22)
 - ☒ claims (claim(s) 1 - 9 , 3 pgs.)
 - ☒ drawings (Fig(s). 1 - 5 , 6 pgs.)
- ☐ Abstract of the Disclosure
- ☐ PCT Fee Calculation Sheet Annex to the Request (PCT/RO/101 (Annex))
- ☐ PCT Demand (PCT/IPEA/401) International Preliminary Exam. Report

- ☐ PCT Fee Calculation Sheet Annex to Demand for Int'l. Prel. Examination (PCT/IPEA/401 (Annex))
- ☐ Executed Declaration/Power of Attorney
- ☐ Unexecuted Declaration/Power of Attorney
- ☐ PCT Notice of Confirmation of Precautionary Designations (PCT/RO/144)
- ☐ Appointment of Agent
- ☒ Preliminary Amendment
- ☐ Assignment/Assignment Recordation Form Cover Sheet (PTO-1595)
- ☐ Information Discl. Statement Transmittal Letter
- ☒ Information Disclosure Citation (PTO-1449)
- ☒ Information Disclosure Statement w/ document(s)

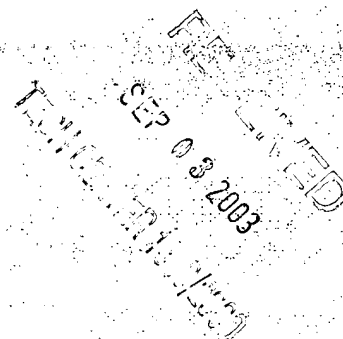
- ☒ Check for \$ 860.00 is enclosed
- ☐ Check for \$ is enclosed
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(7/01)





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SEP 03 2003

TECHNICAL Patent

Attorney's Docket No. 012627-024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
)
Colin L. MASTERS) Group Art Unit: Unassigned
)
Application No.: Unassigned) Examiner: Unassigned
(Corresponding to PCT/DE00/00693))
)
International Filing Date: 1 March 2000)
)
For: COPPER AGONIST THAT BINDS)
ON THE COPPER BINDING SITE)
OF APP AND/OR EXERTS AN)
INHIBITING EFFECT ON THE)
RELEASE OF AMYLOID A β)
PEPTIDE)

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Prior to examination, please amend the above-captioned application as follows:

IN THE CLAIMS:

Kindly replace claims 1-5 as follows.

1. (Amended) A method for the prevention or treatment of Alzheimer's disease comprising using a copper agonist which binds to the copper binding site of the amyloid precursor protein (APP) and/or reduces or prevents the release of the amyloid A β peptide.

9-4-01 CRS